

**REMARKS / ARGUMENTS**

Claims 1-38 are pending in the instant application. Claims 1, 11, 21 and 32 are independent. Claims 2-10, 12-20, 22-31 and 33-38 depend from independent claims 1, 11, 21 and 32, respectively.

By this Amendment, claims 1, 11-21, and 32 have been amended, as set forth above, to further clarify the language used in these claims and to further prosecution of the present application. Support for the new claim amendments may be found in, for example, Fig. 2 and paragraph 52 of the specification. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 11-20 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over USPP 2002/0104099 ("Novak"), in view of USP 6,774,926 ("Ellis").

Though the Applicant generally disagrees with such rejections, to expedite allowance of various pending claims, the following discussion will focus in part on particular independent and dependent claims and/or portions thereof. Note that such focus is in no way to be construed as the Applicant agreeing with any rejections not specifically discussed below. The Applicant respectfully traverses the above rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

## **I. REJECTION UNDER 35 U.S.C. § 101**

Claims 11-20 are rejected under 35 U.S.C. § 101. More specifically, the Examiner states the following in p. 4 of the Office Action:

Claims 11-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 11 sets forth a "machine-readable storage." However, the specification as originally filed does not explicitly define the machine-readable storage. The United States Patent and Trademark Office (USPTO) is obliged to give claims their broadest reasonable interpretation consistent with the specification during proceedings before the USPTO. *See In re Zietz*, 893 F.2d 319 (Fed. Cir. 1989) (during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow). The broadest reasonable interpretation of a claim drawn to a machine-readable storage (also called computer readable storage media and other such variations) typically covers forms of non-transitory tangible media and transitory propagating signals *per se* in view of the ordinary and customary meaning of computer readable media, particularly when the specification is absent an explicit definition or is silent. *See* MPEP 2111.01. When the broadest reasonable interpretation of a claim covers a signal *per se*, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. *See In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and *Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101*, Aug. 24, 2009; p. 2.

The Examiner is referred to the following citation from the 1/26/2010 guidelines by USPTO Director David J. Kappos regarding "Subject Matter Eligibility of Computer Readable Media":

The USPTO recognizes that applicants may have claims directed to computer readable media that cover signals *per se*, which the USPTO must reject under 35 U.S.C. § 101 as covering both non-statutory subject

matter and statutory subject matter. In an effort to assist the patent community in overcoming a rejection or potential rejection under 35 USC § 101 in this situation, the USPTO suggests the following approach. A claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 USC § 101 by adding the limitation "non-transitory" to the claim. *Cf. Animals - Patentability*, 1077 *Off. Gaz. Pat. Office* 24 (April 21, 1987) (suggesting that applicants add the limitation "non-human" to a claim covering a multicellular organism to avoid a rejection under 35 U.S.C. § 101). Such an amendment would typically not raise the issue of new matter, even when the specification is silent because the broadest reasonable interpretation relies on the ordinary and customary meaning that includes signals per se.

Pursuant to the above guidelines by USPTO Director Kappos, the Applicant has inserted the term "non-transitory" to overcome the 35 U.S.C. § 101 rejection. The Applicant notes that, as mentioned by Director Kappos above, such an amendment does not raise the issue of new matter since a signal per se is not the only viable embodiment contemplated by the claims.

Therefore, the Applicant submits that the rejection of claims 11-20 under 35 U.S.C. § 101 has been overcome and claims 11-20 are allowable.

### REJECTION UNDER 35 U.S.C. § 103

The determination of obviousness is a legal conclusion based on underlying findings of fact.<sup>1</sup> The factual inquiries, set forth in *Graham v. John Deere Co.*<sup>2</sup>, include: (1) the scope and content of the prior art, (2) the differences between the prior art and the claims, (3) the level of ordinary skill in the relevant art, and (4) any objective indicia of non-obviousness. Initially, the burden is on the Examiner to establish a *prima facie* case of obviousness<sup>3</sup>. “If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.”<sup>4</sup> More specifically, MPEP at § 2142 states:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

“The determination of obviousness is made with respect to the subject matter as a whole, not to separate pieces of the claim.”<sup>5</sup> Accordingly, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.”<sup>6</sup> If, considering the claim as a whole, the Examiner deems the claim to be obvious in view of the prior art, the Examiner must provide a “clear articulation of the reason(s) why the

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<sup>1</sup> *Sanofi-Synthelabo v. Apotex, Inc.*, 550 F.3d 1075, 1085 (Fed. Cir. 2008).

<sup>2</sup> 383 U.S. 1, 86 S.Ct. 684 (1966)

<sup>3</sup> MPEP § 2142

<sup>4</sup> *Id.*

<sup>5</sup> *Apotex*, 550 F.3d 1075 at 1086. (citing *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007); *Kimberly-Clark Corp. v. Johnson & Johnson*, 745 F.2d 1437, 1448 (Fed.Cir.1984)).

<sup>6</sup> MPEP § 2143.03 (quoting *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970)).

claimed invention would have been obvious.”<sup>7</sup> The Examiner’s determination of obviousness “cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”<sup>8</sup>

In reviewing an Examiner’s determination of obviousness, “the Board cannot simply reach conclusions based on its own understanding or experience—or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.”<sup>9</sup>

With these principles in mind, the Applicant now turns to the claim rejections, in particular.

## **II. The Proposed Combination of Novak and Ellis Does Not Render Claims 1-38 Unpatentable**

### **A. Independent Claims 1, 11, 21 and 32**

With regard to the rejection of independent claim 1 under 35 U.S.C. § 103(a), the Applicant submits that the combination of Novak and Ellis does not disclose or suggest at least the limitation of “determining at a second geographic location, when personal media is scheduled in at least one constructed display for presentation at a first geographic location, wherein said scheduling is performed at said first geographic

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<sup>7</sup> MPEP § 2142.

<sup>8</sup> *KSR*, 550 U.S. 398 at 418 (quoting *In re Kahn*, 441 F.3d 977, 988, (Fed. Cir. 2006)).

<sup>9</sup> *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). *See also In re Vaidyanathan*, Appeal 2009-1404 at 18-19 (Fed. Cir. May 19, 2010) (nonprecedential) (“If the examiner is able to render a claim obvious simply by saying it is so, neither the Board nor [the Federal Circuit] is capable of reviewing that determination. ... If there is neither record evidence nor detailed examiner reasoning, the Board should not conclude that [the Appellant’s] claims are obvious.”).

location, and wherein said determining is performed without communicating said personal media or said at least one constructed display of the personal media outside of said first geographic location," as recited by the Applicant in independent claim 1.

The Office Action states the following:

Regarding claim 1, Novak et al teaches a method for processing media for selection and playback in a communication network, the method comprising: determining at a second geographic location (i.e. determination of scheduled broadcast media using an EPG 153, which is constructed/produced by a local studio 106 and/or cable service provider 108) (Figure 1, Para. 0038-39, 0041 ), wherein said scheduling is performed at said first geographic location (i.e. personal media can be scheduled by an individual acting as a program director, upload source)(Figures 1, 6 and 7; Para. 0067-68); acquiring at said second geographic location, information related to broadcast media from at least one media provider and information related to said personal media, wherein said information related to said broadcast media is associated with a media subscription established at said first geographic location (i.e. acquisition of synthetic broadcast channel including information with respect to personal media from an upload source, wherein synthetic broadcast channel can be provided to end user(s) via subscription) (Figures 1,6-7; Para. 0010,0039,0058,0067-68 and 0070); and updating from said second geographic location, said at least one constructed display, based on said acquired information (i.e. local studio 106 and/or provider 108 updating EPG based on information received) (Figures 1 and 2; Para. 0010, 0041 and 0079). However, the reference is unclear with respect to when personal media is scheduled in at least one constructed display for presentation at a first geographic location.

In similar field of endeavor, Ellis et al teaches a personal television channel system in which contributors such as individuals in the home may create personal television channel programming and may set up scheduling for the personal television channel programming- whereby the contributor and the viewers may use the same user equipment thus enabling a contributor to receive scheduling information of personal and/or traditional television channels (Abstract; Fig. 1; col. 1, lines 46-51; col.2, line 65 to col.3, line 6; col.3, lines 18-28; col A, lines 59-61 ; col.5, lines 15-22; col. 11, lines 45-51; col. 14, lines 23-32).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teaching of the Novak reference with those of the Ellis et al. reference in order to allow a contributor to receive the personal channel listing that they have contributed. A person of ordinary skill in the art would have been motivated to make such a modification to the Novak reference so as to provide an overall more enjoyable viewing experience by permitting a contributing party to view personal media programming that they are most likely to be interested in.

See Office Action at pages 6-8. Additionally, the Examiner states the following in the "Response to Arguments" section at p. 2-3 of the Office Action:

With respect to claim 1, applicant argues cited reference fails to teach claimed limitation "determining at a second geographic location, when personal media is scheduled in at least one constructed display for presentation at a first geographic location, wherein said scheduling is performed at said first geographic location." The examiner respectfully disagrees.

Novak et al teaches determination of scheduled broadcast media using an EPG 153, which is constructed/produced by a local studio 106 and/or cable service provider 108) (Figure 1, Para. 0038-39, 0041), wherein personal media can be scheduled by an individual acting as a program director, upload source)(Figures 1,6 and 7; Para. 0067-68). Furthermore, upload source 122 can have an agreement or communication with the local studio 106 and/or provider 108, such that the presence of and URL address of the web site 124 is known to these parties. These parties can make arrangements to allow cable subscribers to be provided with media program from website and to provide/update the EPG 153 with media programs that are available from the website (Figures 1, 6-7; Para. 0041). Therefore, **Novak's EPG not only consist exclusively of broadcast media but also is able to provide personal media.**

(Emphasis added). The Examiner seems to rely primarily on the disclosure in paragraphs 0039-0041 of Novak. Even though Novak, at paragraphs 0039-0041, discloses that the upload source 122 can store personal media at the web site/server

124, Novak remains deficient. More specifically, Novak discloses that the personal media stored at the server 124 is communicated to the provider 108 for updating the EPG, and then to the subscribers with the updated EPG (See Novak at paragraph 41 as well as communication link between 124 and 108 in Fig. 2). In this regard, if the upload source 122 location is the “first geographic location” then the personal media is still being communicated outside of the “first geographic location” by virtue of posting it to the server 124, and also by virtue of communicating it to the cable provider 108, prior to any determination at another geographic location (e.g., at a location of a consumer receiving the EPG) of whether personal media is scheduled in a constructive display for presentation at the another location. Ellis does not overcome this deficiency of Novak.

Therefore, the combination of Novak and Ellis does not disclose or suggest at least the limitation of “determining at a second geographic location, when personal media is scheduled in at least one constructed display for presentation at a first geographic location, wherein said scheduling is performed at said first geographic location, and wherein said determining is performed without communicating said personal media or said at least one constructed display of the personal media outside of said first geographic location,” as recited by the Applicant in independent claim 1.

#### **B. Rejection of Dependent Claims 2-10, 12-20, 22-31 and 33-38**

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11, 21 and 32 under 35 U.S.C. § 103(a) as being unpatentable



over Novak in view of Ellis has been overcome and requests that the rejection be withdrawn. Claims 2-10, 12-20, 22-31 and 33-38 depend from independent claims 1, 11, 21 and 32 respectively, and are, consequently, also respectfully submitted to be allowable based on the above arguments.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 1-38.

In general, the Office Action makes various statements regarding claims 1-38 and the cited references, which statements are now moot in light of the above. Thus, the Applicant will not address such statements at the present time. However, the Applicant expressly reserves the right to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a rejection of any current or future claim).

**CONCLUSION**

Based on at least the foregoing, the Applicant believes that all claims 1-38 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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